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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,556	10/16/2003	Jun Wan	05-03-004	7136
45113	7590	12/19/2006	EXAMINER	
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SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/19/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/687,556

Applicant(s)

WAN ET AL.

Examiner

Russell Frejd

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10, 12-17 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 4, 11, 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Serial Number: 10/687,556

In re Application of: Wan et al.

Examination of Application #10/687,556

1. Claims 1-21 of application 10/687,556, filed on 16-October-2003, are pending in the application. This communication is in response to the amendment received on 25-September-2006.

Claim Rejections under 35 U.S.C. § 101

2. 35 U.S.C. 101 reads as follows:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

- 2.1 Claims 1-3, 5-10, 12-17 and 19-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- 2.2 MPEP Section 2106(IV)(C) provides that a statutory computer process is determined not by how the computer performs the process, but by what the computer does to achieve a practical application with a useful, concrete and tangible result. For example, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory, while a claimed process for digitally filtering noise employing the mathematical algorithm is statutory. In view of the aforementioned requirement and the interim guidelines for 101 subject matter eligibility, which are now included in section 2106 of the MPEP 8th Edition, the Examiner respectfully contends that the claim language of independent claims 1, 8, and 15, do not claim a practical application or provide a useful, concrete and tangible result, that language claiming: (In regard to claim 1)

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generating (emphasis added) a first view of an object model;

identifying first-view edges and faces;

generating a second view:

identifying second-view edges: and

assigning a region to each of the edges and faces.

2.3 For at least these reasons, the Examiner respectfully posits that claims 1-3, 5-10, 12-17 and 19-21 of the present invention do not meet the criteria for a statutory process, because the claims, specifically the assigning step, are useful and concrete, but are not tangible. Assigning is determined by the Examiner to be a determination, but not an application of the determination.

2.4 In view of the aforementioned requirement, the Examiner respectfully contends that the claim language of claims 15-17 and 19-21 do not claim a practical application, that language claiming a machine-readable media having software for verifying a property of a design of a system. The media holding instructions is determined to recite data embodied on a computer-readable medium. However, the data does not impart functionality to either the data as claimed or to the computer. As such, the claimed invention recites non-functional descriptive material, *i.e.*, mere data. Non-functional descriptive material is merely carried on the medium, it is not structurally and functionally interrelated to the medium, and thereby does not manipulate, or execute, appropriate subject matter, and thus cannot constitute a statutory process (MPEP Section 2106).

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Claim Objections

3. Claims 4, 11 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowed Claims

4. Claims 1-21 are deemed allowable over the prior art of record at this time, pending resolution of any rejections noted above, because the prior art does not specifically teach the method for object model processing as claimed.

Remarks

5. The rejections noted above are presented in view of the interim guidelines for 101 subject matter eligibility, which require a practical application with a useful, concrete and tangible result. A remedy for fulfilling this requirement is to store the tangible result, which is why claims 4, 11 and 18 were not rejected under 101.

Also, in regard to claims 15-17 and 19-21, the computer program instructions, or data structures (see Applicant's remarks [p. 12] received with this amendment), are not statutory under the new guidelines, nor are they functionally and structurally interrelated to the medium by merely recording, encoding, or "tangibly embodying" the data structure on the medium. The computer instructions are required to be employed as a computer component, causing the computer to be manipulated to perform the functionality of the descriptive material.

Furthermore, no "technological arts" test was applied by the Examiner in the previous rejection.

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Lastly, Applicant's remarks pertaining to the method of the present invention not being limited to a computer system (see claim 1) are respectfully determined by the Examiner to be inaccurate, as the invention is clearly described in the specification as being an "automated" system, method (process) and computer program product for characterizing manufacturing related features. For this reason, the limitations of claim 1 were determined to be a computer program.

6. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

Response Guidelines

7. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION, AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7.1 Any response to the Examiner in regard to this final action should be

directed to: Russell Frejd, telephone number (571) 272-3779, Monday-Friday from 0530 to 1400 ET, or the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279. Inquiries of a general nature or relating to the status of this application should be directed to the TC2100 Group Receptionist (571) 272-2100.

mailed to: Commissioner of Patents and Trademarks

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P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to: (571) 273-8300

Hand-delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

Date: 9-December-2006



**RUSSELL FREJD
PRIMARY EXAMINER**